

## **REMARKS**

### **THE DRAWINGS**

The drawings are objected to on the ground that they include the numeral reference 482 that is not mentioned in the description. Applicant respectfully refers the Examiner to page 28, line 13 of the specification, that specifically mentions numeral reference 482. Therefore, no correction is needed.

### **THE CLAIMS**

#### **REJECTION UNDER 35 U.S.C 102**

Claims 1-3, 5, 6 9-14, 16, 19, 20, 39, 42, 45, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Jain et al. Applicant respectfully submits that this rejection is now moot in view of the current amendment to the independent claims 1, 13, and 39. These latter claims now contain the limitations of claims 4, 15, and 41, respectively, which are subject to the rejection under 35 U.S.C. 103, as discussed below.

#### **REJECTION UNDER 35 U.S.C 103**

##### **A. Independent Claims 4, 15, and 41**

Claims 4, 15, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain et al. in view of Polnerow et al. Applicant respectfully traverses this rejection and submits that the claims on file are not obvious in view of Jain et al. (hereinafter "Jain") in light of Polnerow et al. (hereinafter "Polnerow"), and are

patentable thereover. In support of this position, Applicant submits the following arguments:

## **B. Legal Standards for Obviousness**

The following are court opinions set the general standards in support of Applicant's position of non-obviousness, with emphasis added for clarity purpose:

- “**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination.” *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). “
- “When a rejection depends on a combination of prior art references, **there must be some teaching, suggestion, or motivation** to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).” **Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation** to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- “With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of these findings.” See *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001).
- “We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568,

1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, **the showing must be clear and particular**. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See In re Dembiczak, 175 F. 3d 994 (Fed. Cir. 1999).

- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed**." See In re Rouffet, 149, F.3d 1350 (Fed. Cir. 1998).
- MPEP 2143.01-"The Prior Art Must Suggest The Desirability Of The Claimed Invention. There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (**The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.**). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

- If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

### **C. Application of the Obviousness Standard to the Present Invention**

#### **C.1. Elements not disclosed by Jain**

Applicant respectfully submits that the following elements and combination of elements and resulting features recited in the representative independent claim 1 and the claims dependent thereon, are not disclosed in Jain (with emphasis added):

“1. A system for automatically associating contextual input data with available multimedia resources, comprising: ...

an assistant device for processing the contextual input data captured by the contextual input device, and for **formulating a query based on processed contextual input data and a user profile**; and

a contextual multimedia association module for **associating the processed contextual input data** with the multimedia resources and for generating association matches.” Emphasis added.

#### **C. 2. Jain does not teach automatically formulating the query based on the contextual input data and the user profile**

As ground for the obviousness rejection of claim 1, the office action states that **Jain et al. teach all the limitations of claims 4, 15, and 41, except “wherein the assistant device automatically formulates the query based on a user profile.”** In order to compensate for this missing element, the office action resorts to Polnerow, as discussed below.

### C. 3. The combination of Jain and Polnerow is improper

In support of the combination of Jain and Polnerow, the office action adds that Polnerow teaches "searching based on user profile (see col. 10, lines 53-54). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Polnerow within the system of Jain by automatically searching database for information based on user profile within the contextual input data and multimedia data system associating system and method because, **Jain teaches that there needs to be an efficient way for performing comparison by reducing time** (see col. 3, lines 55-58), thus by allowing a search to be performed automatically based on data stored in the users profile database by allowing the search to be performed when the server does not experience high data request and download rates, would dramatically reduce time." Emphasis added.

Applicant respectfully traverses this rejection ground, and submits that Jain and Polnerow cannot be properly combined under the current law, to form a viable obviousness rejection ground. More specifically, **neither Jain nor Polnerow provides a teaching, motivation, or suggestion to incorporate the user profile-based search in the context searching system of Jain**. As presented earlier, even if the combination of the references teaches every element of the claimed invention, however **without a motivation to combine, a rejection based on a prima facie case of obvious is improper**.

The office action reasoning for combining Jain and Polnerow is that "Jain teaches that there needs to be an efficient way for performing comparison by reducing time." Such reasoning is conclusory in nature, and is not tantamount to a teaching, motivation, or suggestion. Thus, it does not satisfy the prima facie requirement of obviousness, as necessitated by the current law.

The office action further states, in essence, that as a result of such combination time would be dramatically reduced. Such a result, would be the "effect" of hind sight combination rather than the "cause" or "motivation" for the combination. The current law does not require the "effect" to be viable, but rather that the "motivation" be present.

Consequently, since the only reasoning given by the office action in support of the combination of the two references is conclusory in nature based on the examiner's "understanding and experience," rather than presenting concrete "evidence" as required by the current law, and further since the showing by the office action is not "clear and particular," also as required by the current law, then "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence," and do not form a proper basis for the obviousness rejection.

To conclude, Applicant respectfully submits that the office action does not provide justifiable reasons and support for a prime facie obviousness rejection. A wish or a desire to reduce time, without further reasoning or support, is insufficient to satisfy the legal requirements for an obviousness rejection.

Claim 1 and the claims dependent thereon are allowable, and such allowance is respectfully requested. Similarly, independent claims 13 and 39 and the claims dependent thereon are allowable for reciting comparable elements to those of claim 1.

## **D. Dependent Claims**

### **D. 1. Ground rejection of claims 7, 17, and 43**

The office action states that the dependent claims 7, 8, 17, 18, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain in view of Bull. More specifically, with regard to claims 7, 17, and 43, the office action offers the following rejection ground: “Jain teaches all the limitations except wherein the assistant device develops a digital profile for a user **based on association matches, which was previously presented to the user**. Bull teaches of developing a user profile (see col.7, lines 53-57). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Bull within the system of Jain by developing a user profile within the contextual input data and multimedia data system associating system and method because, this would keep track of the potential future user as well as keep track of the user's preferences for future search "primitives" to speed up the processing time.”

### **D.2. Elements not disclosed in the combination of Jain and Bull**

As ground for the obviousness rejection of claim 1, the office action states that “Jain teaches all the limitations except wherein the assistant device develops a digital profile for a user **based on association matches, which was previously presented to the user**.” In order to compensate for this missing element, the office action resorts to Bull, as discussed below.

Applicant respectfully submits that the following elements and combination of elements and resulting features recited in the representative dependent claim 7 and the claims dependent thereon, are not disclosed in Jain (with emphasis added):

"7. The system according to claim 3 , wherein the assistant device develops the user profile **based on association matches that were previously presented to the user.**" Emphasis added

**D.3. The combination of Jain and Bull does not disclose the missing elements**

Applicant respectfully submits that claim 7 depends on claim 1, as now amended to include the following element: "formulating a **query based on** processed contextual input data and **a user profile.**"

The office action did not address this newly added element in connection with Jain and Bull. Nonetheless, even if the teaching of Polnerow were combined with those of Jain and Bull, the present invention, as recited in claim 7, is still distinguishable over the hypothetical combined design of Jain, Bull, and Polnerow.

As described earlier in favor of allowance of the independent claim 1 in view of Jain and Polnerow, the combination of these two references does not teach the "formulating a **query based on** processed contextual input data and **a user profile.**"

The office action resorts to Bull for teaching the development of a user profile. Applicant admits that the development of user profiles has been known, and submits that **the invention does not profess to claim the creation of user profiles, but rather to the formulation of queries based on user profiles that have been processed in accordance with the present invention.**

As a result, the combination of Jain and Bull does not disclose the following elements of claim 7:

- "formulating a query based on processed contextual input data and a user profile"; and



- “the assistant device develops the user profile based on association matches that were previously presented to the user”.

Claim 7 and the claims dependent thereon are allowable, and such allowance is respectfully requested. Similarly, independent claims 17 and 43 and the claims dependent thereon are allowable for reciting comparable elements to those of claim 7.

#### D. 4. Ground rejection of claims 8, 18, and 44

The office action states that with regard to claims 8, 18, and 44, “**Jain does not teach wherein the assistant device updates the user digital profile based on recent association matches.** Bull teaches of updating the user digital profile based on recent association matches (see col.8, line 65 to col.9, line 2 and col.12, lines 2-4). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Bull within the system of Jain by updating user profile within the contextual input data and multimedia data system associating system and method because, this would keep track of the potential future user as well as keep track of the user's preferences for future search "primitives" to speed up the processing time.” Emphasis added.

#### D.5. Elements not disclosed in the combination of Jain and Bull

Applicant respectfully submits that the following elements and combination of elements and resulting features recited in the representative dependent claim 8 and the claims dependent thereon, are not disclosed in Jain (with emphasis added):

"8. (Previously amended) The system according to claim 7, wherein the assistant **device updates the user digital profile based on recent association matches**." Emphasis added

**D.6. The combination of Jain and Bull does not disclose the missing elements**

Applicant incorporates herein the presentation made earlier in favor of the allowance of claim 7, and further respectfully submits that claim 8 depends on claims 1 and 7 as now amended, to include the following elements that are missing from Jain and Bull:

- "formulating a query based on processed contextual input data and a user profile";
- "the assistant device develops the user profile based on association matches that were previously presented to the user"; and
- "the assistant device updates the user digital profile based on recent association matches".

Claim 8 and the claims dependent thereon are allowable, and such allowance is respectfully requested. Similarly, independent claims 18 and 44 and the claims dependent thereon are allowable for reciting comparable elements to those of claim 8.

**TELEPHONE INTERVIEW**

Applicant respectfully requests a telephone interview with the following agenda:  
Discuss claim 8 in view of Jain, Polnerow, and Bull.

## **CONCLUSION**

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Respectfully submitted,



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Samuel A. Kassatly  
Attorney for Applicant  
Reg. No. 32,247  
Tel. (408) 323-5111